REMARKS

Claims 1-13 are pending. Reconsideration of the pending claims in view of the remarks below.

The Pending are Inventive

Claims 1-13 stand rejected under 35 U.S.C. § 103 as allegedly being unpatentable over U.S. Patent No. 6,322,504 to Kirshner in view of U.S. Patent Application Publication No. 2002/0072933.

The examiner bears the burden of establishing a prima facie case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, (Fed. Cir. 1993). Only if this burden is met does the burden of coming forward with rebuttal argument or evidence shift to the applicant. *Id.* at 1532. When the references cited by the examiner fail to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988).

To establish a *prima facie* case of obviousness, the Office must cite one or more references which, inter alia, teach or suggest all the claim limitations and provide some suggestion or motivation, either in the references or in the knowledge generally available among those of ordinary skill in the art, to modify the reference. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974) and *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). Applicants submit that the cited references fail to support a *prima facie* case of obviousness because neither of these have been shown.

The cited art does not teach or suggest all the limitations of the pending claims. For example, the Office has alleged that Kirshner teaches the step of selecting a population of patients that is suspected of having a higher than normal risk for a preselected medical condition, and points to col. 6, lines 22-28 of Kirshner to support the allegation. Contrary to the Office's position, Kirshner at the cited passage does not explicitly disclose the step of selecting a population of patients. Instead, the text cited teaches evaluating a patient for the presence of coronary artery disease (CAD) and chest pain. The disclosure in this passage is insufficient to support the Office's allegation that it provides an example of identifying a population of patients suspected of having higher than normal risk for a preselected condition. Vonk similarly does not teach this selection

step. As such, the proposed combination does not teach all the limitations of the claimed invention and therefore does not support a prima facie case of obviousness.

Similarly, with respect to claims 5 and 6, there is no explicit disclosure in either reference of pulmonary disease or congestive heart failure as the preselected medical condition. Although both references mention diabetes, Kirshner only references diabetes with respect to a risk factor for CAD, not as a preselected medical condition, and Vonk discloses diabetes in paragraph 74 as a secondary co-morbidity, and in paragraph 93, with respect to other tools such as the Diabetes Quality Improvement Project. Furthermore, regarding claim 7, Kirshner merely discloses that an individual may use the internet to access the system, but does not disclose that the recommendations outcome is sent to a health care provider. Vonk discloses internet communication but does not disclose the step of sending recommendations outcome to a health care provider.

In addition to failing to cite references which teach or suggest all the limitations of the pending claims, the combination cited by the Office also fails to provide the requisite motivation to combine or modify the cited references to achieve the claimed invention. Kirshner's disclosure is directed to determining an individual's risk of developing a disease and the consequences of the disease while Vonk's method is directed to monitoring a patient's status and providing recommendations for improved patient health care. Nothing in either of these references would suggest combining them to achieve the claimed invention.

Because the references cited by the Office fail to support a *prime facie* case of obviousness, the present rejection should be withdrawn.

CONCLUSION

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 355592000200. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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